

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN K. ECKL

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Appeal No. 2006-1650  
Application No. 09/903,500  
Technology Center 3600

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Decided: March 29, 2007

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Before WILLIAM F. PATE, JENNIFER D. BAHR, and ANTON W. FETTING,  
*Administrative Patent Judges.*

WILLIAM F. PATE, *Administrative Patent Judge.*

DECISION ON APPEAL  
PRELIMINARY MATTERS

A party, such as Appellant, dissatisfied with a Decision of the Board in an *ex parte* appeal of an application has two courses of action. The party may request rehearing (reconsideration) under 37 C.F.R. § 41.52, or the party may seek judicial review by appeal or civil action. See 37 C.F.R. § 1.197(b) and 37 C.F.R. § 1.304(a)(1). The *ex parte* patent regulations and the jurisprudence do not provide

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for the re-appeal and thus a renewed consideration by the Board of the same claims as previously considered based on the same record. *See In re Russell*, 439 F.2d 1228, 1230, 169 USPQ 426, 428 (CCPA 1971)(*res judicata* rejection reversed where two new affidavits were presented to change evidentiary record); *Ex parte Swanson*, 215 USPQ 564, 565 (Bd. App. 1982) (examining the patentability of the same invention for a second time on a different record does not create an onerous burden on the PTO).

In a prior appeal, Appeal No. 2003-2167, this Board considered the patentability of claims 12 and 14-36 in Appellant's parent application. The Examiner's rejections of all claims were affirmed. Subsequent to that Decision, Appellant filed an RCE. According to Appellant's Brief, claims 12, 18, and 19 have been amended (Br. 4). Thus, according to Appellant, claims 21-36 have not been amended and are the same claims considered by this Board in Appeal No. 2003-2167. Furthermore, the evidentiary record remains the same. Thus, the issue raised by the appeal of these unamended claims is precisely identical to the issue raised with respect to these claims in the prior appeal. Having previously decided the disposition of these claims on the same evidentiary record, this re-appeal, as it were, is merely a stratagem to outflank the regulations established for the orderly review of Board decisions we quoted at the outset. Accordingly, we will not revisit our prior decisions in this manner.

Consequently, we DISMISS the appeal as to claims 21-36, the patentability of claims 21-36 having been previously decided on the same record. The appeal will go forward as to claims 12 and 14-20, claims that were amended subsequent to the Decision rendered in Appeal No. 2003-2167.

## STATEMENT OF THE CASE

This is the second appeal from a final rejection of claims 12 and 14-20. The appeal as to claims 21-36 has been dismissed.

The claimed invention is both a method for delivering billing statements and a billing system for delivering billing statements. The method and system deliver a recipient's bill either by printing and mailing or by furnishing an electronic copy. A bill recipient's preferences for billing are stored on a computer and are utilized to determine the manner of billing.

The references of record relied upon by the examiner as evidence of obviousness are:

Hogan	5,699,528	Dec. 16, 1997
Comesanas	5,802,498	Sep. 1, 1998

Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 stand rejected under 35 U.S.C. § 103 as unpatentable over Comesanas.

Claims 16, 24, 28, and 35 stand rejected under 35 U.S.C. § 103 as unpatentable over Comesanas in view of Hogan.

Appellant has not argued the rejections on appeal separately. Although the Appellant has set forth portions from two different claims remaining in this appeal for argument in the Brief at 8, the Appellant consolidated the argument for all claims based upon their common elements on the following page.

## ISSUE

The sole issue for our consideration is whether the examiner, by a preponderance of the evidence, has established the prima facie obviousness of the independent claims 12 and 18.

### FINDINGS OF FACT

As shown in Figures 1 and 2, Comesanas' invention provides an automated, computer-directed means by which banking institutions and credit card companies may attempt to expedite the return of invoice payments. At the same time, Comesanas' invention provides a service for customers by providing the customer with a time saving pre-paid envelope for return of an invoice payment. In the preferred embodiment, after the computer software billing system is properly loaded into the computer memory and executed, the computer would access a database containing debtor account information. Then after reviewing information presented for the first debtor account, the computer would decide whether a payment was required for that debtor, and, if so, generate an invoice for the first debtor account so that the creditor's address is in a consolidated position on the invoice for use with a return envelope having a window and so that the debtor's current address is also in a consolidated position on the invoice for use with a shipping envelope having a window. The computer would then determine from the information in the database whether or not the first debtor has signed an agreement to pay transmittal charges associated with a return envelope. If the debtor has signed such an agreement, the transmittal charges would be added to the invoice. (See Comesanas, column 2, line 55 to column 3, line 5).

The computer would then direct a printer to print an invoice for the first debtor.

Comesanas teaches (column 3, lines 5-45) that:

In a second embodiment of the present invention (not shown), it is contemplated for a creditor [to] have the option to eliminate the step of printing a paper copy of the invoice when the invoice information is electronically transmitted to the debtor.

Transmittal of the invoice to each debtor is contemplated in two ways. In today's business environment a shipping envelope is routinely required. However, in the future, it is contemplated for transmittal of invoices and invoice payments to be accomplished electronically and for the existence of transmittal charges for such electronic transmittal. *The present invention can be used in an all-electronic business environment whereby, for the debtor's convenience in being allowed to make return payments electronically, the debtor signs a print written agreement that he authorizes being billed on his or her invoice for electronic transmittal charges that would otherwise be incurred by the creditor for such electronic return payment and for which the creditor would be unwilling to pay[.]*

Should envelopes be required, the computer will determine whether an address is needed for either the shipping envelope or the pre-paid return envelope. If addresses are required, the computer will direct a printer to print the creditor's address on the pre-paid return envelope and the debtor's current address on the shipping envelope. It is not critical to the present invention which envelope is printed first. The computer will then direct a postage metering device to print transmittal charges onto the shipping envelope and onto the return envelope as needed. Again, it is not critical to the present invention which envelope is printed first. The computer-aided billing system will then have the computer direct the collation or assembly of the pre-paid return envelope, the shipping envelope, and the invoice for transmittal to the customer. This process is repeated for each successive debtor in the database. As the operating speeds of printers and postage metering devices are variable, the order of the steps included herein may be varied to the extent necessary to maximize the efficiency of each printer and each postage metering device used by a creditor without departing from the fundamental intent of the present invention. (Emphasis supplied).

## PRINCIPLES OF LAW

“A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art.”

*In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006) citing 35 U.S.C. § 103(a) (2000); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 467 (1966). “The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact.” *Id.* (citing *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)).

“In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in *Graham v. John Deere Co.* 383 U.S. at 17, 148 USPQ at 467. The Board determines ‘the scope and content of the prior art,’ ascertains ‘the differences between the prior art and the claims at issue,’ and resolves ‘the level of ordinary skill in the pertinent art.’” *Id.* (citing *Dann v. Johnston*, 425 U.S. 219, 226, 189 USPQ 257, 261 (1976)) (quoting *Graham*, 383 U.S. at 17, 148 USPQ at 467). “Against this background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention.” *Id.* (citing *Graham*, 383 U.S. at 17, 148 USPQ 467).

## ANALYSIS

We affirm the rejection of claim 18 on two grounds. First, the claim does not specify what delivery preference the recipient chooses to the level of detail argued by the Appellant. The term “delivery preferences” as it appears in the preamble and in the body of the claim is broader than whether the recipient desires electronic or paper mail transmission<sup>1</sup>. The term “delivery preferences” is broad

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<sup>1</sup> The specification refers to the choice of whether paper or electronic delivery is preferred as a customer choice of delivery *mode* (emphasis added), this being one of several examples of delivery preferences enumerated on p. 4.

enough to read on a recipient's preference to be billed on a certain date, to be billed monthly or quarterly, or indeed to have the electronic transmittal charged to the recipient's account. Since Comesanas clearly allows the recipient to choose whether to pay electronic transmittal charges, and payment of the electronic transmittal charge is a preference afforded the debtor/customer, Comesanas clearly establishes the prima facie obviousness of claim 18 due to the breadth of the term "delivery preferences."

As further evidence that our broad reading of the term is the correct one, we point out that "delivery preferences" seems to denote more than one preference. Thus the term appears to subsume more than choosing mail or electronic delivery.

We further note that the only relationship between these preferences and the determination of printed or electronic transmission is an association with billing information. The claimed transmission determining may arise from the billing information, or some consequence of the association rather than from the preferences alone.

Secondly, even if "delivery preferences" in claim 18 were construed to mean solely a preference for electronic or paper mail billing, claim 12 and claim 18 are obvious over Comesanas for the following reason.

According to Appellant, the following facts are not in dispute:

1) The debtor can sign an agreement authorizing the creditor to include a return transmittal charge on the invoice.

2) The invoice/payment transaction can occur by physical mail or electronic delivery. (Reply Br. 2).

To these facts we add one more fact inferred from the italicized sentence in our findings and one finding based on human nature:

3) The debtor/customer cannot select electronic delivery without agreeing to the electronic payment transmittal charge.

4) A debtor/customer is unlikely to pay for services the debtor/customer does not desire, i.e. payment for services implies a desire for those services.

The debtor/customer cannot select electronic delivery without agreeing to the electronic payment transmittal charge, because to enable electronic payment of transmittal charges the debtor/customer must submit a signed written agreement acceding to these charges. As disclosed, unless the debtor/customer chooses to pay this fee, the debtor/customer cannot receive electronic billing. There is simply no choice offered for electronic payment without payment of the electronic transmittal charges. Thus, the agreement to pay the transmittal charges is an agreement, that implies a preference, to receive an electronic bill—and it is the customer's choice, the customer's preference. It is a necessity for a recipient to choose electronic billing if the recipient agrees to the electronic transmittal fee and signs the written agreement to be responsible for electronic transmittal charges. Thus, we are in agreement with the Examiner and the prior Panel that the preference for an electronic bill as against a paper one is inherent in the choice made by the recipient to select electronic transmittal in the disclosed process of Comesanas. Since the argued “delivery preference” is inherent in the prior art, Comesanas renders obvious the subject matter of Appellant's independent claims.

## CONCLUSION

Inasmuch as the examiner has established the prima facie obviousness of independent claims 12 and 18 on appeal, the rejection of all claims on appeal is affirmed.

## ORDER



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The Appeal as to claims 21-36 is dismissed.

The rejections of claims 12 and 14-20 are affirmed.

No time for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

APPEAL DISMISSED AS TO CLAIMS 21-36; AFFIRMED

JRG

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